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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,863	10/12/2001	John P. Couch	107553.01	7457

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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3639

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,863

Applicant(s)

COUCH ET AL

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-25 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) is acknowledged.

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120/119(e) as follows:

A) An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR § 1.78(a)(2) and (a)(5)).

2.1 If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application no. 60/239,894 (see declaration), specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

2.2 If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any

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benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

3. The drawings are objected to because

A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:

(1) claims 8 & 16 and the inclusion of "subscriber billing information" in the "informational data set"; and

(2) claim 16 and the step of billing the subscriber based on the "subscriber billing information" in the "informational data set";

must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

B) The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 C.F.R. § 1.81(c).

3.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the

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several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities:

A) the subject matter of:

(1) claims 8 & 16 and the inclusion of "subscriber billing information" in the "informational data set"; and

(2) claim 16 and the step of billing the subscriber based on the "subscriber billing information" in the "informational data set";

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claims 8 & 16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 The subject matter of:

A) claims 8 & 16 and the inclusion of "subscriber billing information" in the "informational data set"; and

B) claim 16 and the step of billing the subscriber based on the "subscriber billing information" in the "informational data set";

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

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6.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.1 Claims 1, 2, 5, 6, 8, 9, 11-15 & 17-21 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Allen et al (5,422,821) or Pintsov et al (EP 0710930).

7.2 Claims 1, 2, 5, 6, 8, 9, 11-15 & 17-21 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Sansone (6,549,892).

7.3 In regard to claims 1, 2, 5, 6, 8, 9, 11-15 & 17-21, any one of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892) disclose a computer implemented mailing system, which under the control of an operating program stored in the memory of the system performs the function of mail processing. The mail/postal processing systems of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892) include obtaining an unique identifier, that is the delivery point code for a particular postal delivery address by a first system obtaining information concerning the name and address of a recipient of the mail from the item of hardcopy mail. The obtained name and address information as obtained by the first system is sent to a second system where the name and address information is electronically converted

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into a corresponding delivery point postal code or the claimed (UVDC) by querying an electronically stored relational database that relates a delivery point postal codes to each deliverable address. The delivery point postal code as determined by the second system is then affixed/printed on the corresponding item of the mail as a machine readable code or barcode by a third system so that one or more fourth systems that comprise the mail sorting and processing machines of the post office may detect the delivery point postal code and use it to control the mail processing machines to directs the item of mail to the physical mailing address represented by the delivery point postal code.

7.3.1 It is noted that since each deliverable address has it's own delivery point postal code, each time a postal customer moves there would be a new delivery point postal code associated with the customer and hence, this delivery point postal code would be recognized as the claimed "virtual dynamically-capable address code or (UVDC).

7.3.2 In regard to claims 8, 9, 11, 12, 14, 15, 17-19 & 21, it is noted that either the customer may modify or change or add the customer's address at any time by submitting a change of address information including a physical address of the final delivery point, subscriber contact information and instructions on how the mail is to be delivered or diverted to a mail processing facility.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time

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the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.1 Claims 3, 4, 22 & 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Allen et al (5,422,821) or Pintsov et al (EP 0710930) or Sansone (6,549,892) as applied above to claims 1, 2, 5, 6, 8, 9, 11-15 & 17-21, and further in view of In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950).

8.1.1 In regard to claims 3, 4, 22 & 23 and the use of the internet as a communications link and the location of the data base that electronically stored relational database that relates a delivery point postal codes to each deliverable address, since the systems of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892) require the use of a suitable communications link to access the electronically stored relational database, it would have been obvious to one of ordinary skill at the time of the invention that the electronically stored relational database could be located at any suitable location that mail processing machines could access via any suitable type of communication link, since neither the location of the electronically stored relational database nor the type communications link being used to request a (UVDCA) would affect the operation of the systems of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892).

8.2 Claims 7 & 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either Allen et al (5,422,821) or Pintsov et al (EP 0710930) or Sansone (6,549,892) as applied above to claims 1, 2, 5, 6, 8, 9, 11-15 & 17-21, and further in view of a substitution of equivalent devices.

8.2.1 In regard to claim 7 and the use of a keyboard as the input device, since the systems of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892) require that the obtained address information be entered into a computer system and a keyboard is one of many devices that are well established as input devices, it would have been obvious to one of ordinary skill at the time of the invention that systems of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892) could use any suitable type of input device, for example a keyboard, when entering the required address data absent applicant's showing of new and unexpected results from using a particular type of input device in the systems of either Allen et al ('821) or Pintsov et al ('930) or Sansone ('892).

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8.3 Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either Allen et al (5,422,821) or Pintsov et al (EP 0710930) or Sansone (6,549,892) as applied above to claims 1, 2, 5, 6, 8, 9, 11-15 & 17-22.

8.3.1 In regard to claim 25, see above in regard to claims 8, 9, 11, 12, 14, 15, 17-19 & 21.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) in regard to claims 10 & 16 the prior art does not teach or suggest the inclusion of "subscriber billing information is the subscriber information data set.

10. The examiner has cited prior art of interest, for example:

A) Mummert which discloses that the user of the post office's NCOA and zip+4 or 11 digit zip codes when sorting mail can save a mailer money.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/20/05


Edward R. Cosimano
Primary Examiner A.U. 3629